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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,629	11/09/2001	Thierry Monteil	P07428US00/BAS	5942

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LARSON & TAYLOR, PLC
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ALEXANDRIA, VA 22314

EXAMINER

REYES, HECTOR M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/986,629

Applicant(s)

MONTEIL ET AL.

Examin r

Hector M Reyes

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 4-16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority Paper

Examiner acknowledges Official copy of French patent 0014419 and Applicant's Information Disclosure Statement file with the original US instant Application.

Claims Objection

Claims 4, 5, 6, 7, 8, 9, 10, 11, 11, 13, 14, 15 and 16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend-directly or indirectly-from any other multiple dependent claim. See MPEP § 608.01(n). ***Accordingly, the said claims have not been further treated on the merits.***

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3 through 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear which are the specific reactants and reaction conditions required to prepared the acrylamide derivative identified by formula (V). Is the free amine used as a reactant or it is its corresponding salt derivative? Is the free acrylic acid identified by formula (VI) used as a reactant or it is required a further step to activate the said carboxylic acid to a more reactive synthon such as an acid

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chloride? Would the condensation works by the no activated species (free carboxylic acid and free amine) or it is essential that the activated forms be prepared?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 to 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenberg et al, US patent 4,401667 or US patent 4,474799.

Greenberg discloses the thio carboxamide derivatives, described as formula (1), see col. 1, 677 and 799. The said derivatives are prepared from protected thio carboxamide, having formula (IV), as described in col. 3, 677 and 799. Interestingly, Greenberg discloses that the said compound (IV) is prepared by the following sequence of steps:

- 1) Reacting amino acid of formula II or an ester thereof with an acrylic acid or its chemical equivalent of formula (V) in order to obtain the alpha substituted acrylamide (VI). Greenberg indicates that preferably, the acrylic acid of formula (V) is converted to an activated form such as the corresponding acid chloride.
- 2) Once the said alpha substituted acrylamide (VI) is prepared, it is reacted with the thio derivative VII to yield compound derivatives of formula (IV).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Plaquevent et al, US patents:

- 5,599,951,
- 5,670,531 and
- 5,846,956

Wherein a series of amino acid derivatives are prepared.

CONCLUSION

Any inquiry concerning this communication should be directed to Hector M. Reyes whose telephone number is (703) 605-1153. The examiner can normally be reached on Monday to Friday from 8 am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Rotman, whose telephone number, is (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556 or for regular communication and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of the application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Héctor M. Reyes PhD, JD

May 6, 2003



**ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
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